MARSHALL GERSTEIN

Katherine L. Neville, Ph.D.

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For clients seeking patent protection in all areas of biotechnology and pharmaceuticals, Katherine L. Neville, Ph.D. delivers guidance to secure their inventions worldwide. She calls on her advanced studies in microbiology and immunology and over a decade of patent prosecution experience to advance their business goals. In addition to counseling clients in strategic management of worldwide patent rights, her extensive experience includes patent preparation, opinions, due diligence analyses for clients interested in partnering, and various patent proceedings, including interference, reexamination and opposition proceedings. Kate serves clients ranging from non-profit institutions to biotech start-ups to big pharma, and capably understands their diverse needs across a wide range of technologies.

Kate was recognized in the 2016 Women Worth Watching list by *Profiles in Diversity Journal,* a list highlighting women who are using their influence to change their workplace, marketplace, and the world. She has been selected as one of the "World's Leading Patent Practitioners" since 2013 by *Intellectual Asset Management (IAM)* magazine. Since 2018, she has been recognized as a *Illinois Super Lawyer*. From 2014–2017, she was selected for inclusion in the *Illinois Rising Stars*® list, featuring outstanding young attorneys in the state. In recognition of her outstanding patent work in life sciences, Kate has been featured as a "Life Sciences Star" since 2015 in *LMG Life Sciences*. Additionally, she has been named an "IP Star" in the *Managing Intellectual Property* IP Stars Survey since 2014 and was selected for inclusion in *The Best Lawyers in America*©list in the practice area of Patent Law. Kate has also been selected by the *Law Bulletin Publishing Company*'s Leading Lawyer Network as a "Leading Lawyer."

Practices

- Patent Prosecution

Industries

- Biotechnology & Life Sciences
- Non-Profit Technology Transfer
- Pharmaceuticals

Representative Experience

- Responsible for worldwide prosecution for three FDA-approved drugs and numerous additional clinical candidates, including small molecules and biologics.

- Successfully obtained patent protection for next generation antibodies and performed FTO's on potential antibody targets and indications for clients.
- Reliably guided client through freedom to operate analysis and patent application processes in their development of new vaccine therapies for pandemic influenza viruses.

Kate has skillfully worked on patent matters in diverse technologies, including:

- Antibody technology
- Growth factors
- Cell adhesion molecules
- Vaccine compositions
- Diagnostic and therapeutic methods
- Recombinant protein production
- Protein purification
- Transgenic animals
- Cell-based therapeutics
- Genomics/Proteomics

Background and Credentials

Kate has extensively prosecuted domestic and foreign patents, provided due diligence analyses, handled interference, reexamination and opposition proceedings, as well as given non-infringement, patentability, freedom-to-operate, and validity opinions.

She received her J.D., *cum laude,* from The John Marshall Law School. Prior to joining Marshall Gerstein, she earned her Ph.D. from the Department of Microbiology and Immunology at Northwestern University Medical School. Her graduate work focused on experimental models of the autoimmune disease Multiple Sclerosis, specifically investigating potential therapeutic methods involved in the regulation of auto-reactive T cell function and their consequent effects on the progression of autoimmune disease. She received her B.S. in biochemistry from the University of Notre Dame.

Education

- The John Marshall Law School (J.D.)
- Northwestern University (Ph.D.)
    - Immunology
- University of Notre Dame (B.S.)
    - Biochemistry

Bar Admissions

- Illinois
- U.S. Patent and Trademark Office

Publications and Presentations

Kate has published several articles in legal and peer-reviewed scientific journals and frequently presents CLE seminars on emerging topics in the biotech field, such as recent developments in case law as well as current trends at the US Patent and Trademark Office.

- "AI is a Tool — Not a Replacement — For Human Innovation in Drug Discovery," *Drug Discovery Online*, September 4, 2024.
- "How to Incentivize BioPharma R&D with a Culture of Innovation," *PharmaSource,* May 17, 2024.
- "A Period of Adjustment," *Intellectual Property Magazine*, March 2019 issue.
- "Start-up Challenge 2.0," Moderator, Women in Bio-Chicago, September 27, 2016.
- "'Signed, sealed, delivered': Pay-for-delay deals aren't all bad," *IPPro Life Sciences,* April 6, 2016.

See Kate's additional thought leadership.

Community and Professional Involvement

- Women in Bio (WIB)–Chicago Chapter, Former Chair, Member of Advisory Board
- Intellectual Property Law Association of Chicago (IPLAC)

Representative Matters

*Zymogenetics, Inc. v. Kirin Brewery Company, Limited**
U.S. Patent Office Board of Patent Appeals and Interferences
Case Type(s): Patent Interference
Area(s) of practice: Biotechnology

Insights

December 9, 2024
Kate Neville on The Biotech Startups Podcast
The Biotech Startups

September 4, 2024
"AI is a Tool — Not a Replacement — For Human Innovation in Drug Discovery"
Drug Discovery Online

May 17, 2024
"How to Incentivize BioPharma R&D with a Culture of Innovation"
PharmaSource

March 2019 issue
"A Period of Adjustment"
Intellectual Property Magazine

September 27, 2016
“Start-up Challenge 2.0”
Women in Bio-Chicago

April 6, 2016
“‘Signed, sealed, delivered’: Pay-for-delay deals aren’t all bad”
IPPro Life Sciences

June 2014
“Patent Eligibility from the Trenches: Practical Implications of the Supreme Court’s Mayo and Myriad Decisions”
2014 BIO International Convention, San Diego, CA

July 2, 2013
“Are ‘pay for delay’ payments anti-competitive or just another settlement agreement? The Supreme Court sets out criteria for determining whether reverse settlements violate antitrust law”
InsideCounsel

June 4, 2013
“Licensor or licensee, who bears the burden of proving infringement? The Supreme Court seeks to clarify the apparent discrepancy between one of its rulings and the Federal Circuit’s decision in Medtronic v. Boston Scientific”
InsideCounsel

May 7, 2013
“Supreme Court hears oral argument on whether isolated DNA is a product of nature — The history and implications of the upcoming AMP. v. Myriad Genetics decision”
InsideCounsel

April 23, 2013
“Business methods, diagnostics and abstract ideas -- How have Bilski and Mayo impacted claim examination in the PTO?”
InsideCounsel

March 26, 2013
“Federal Circuit goes all in on double patenting—A recent ruling cautions institutions to monitor the inventorship of assigned patents”
InsideCounsel

February, 23, 2013
“The Notebook, end of a love story? 3 reasons to be diligent with witnessing notebooks post AIA”
InsideCounsel

Client Successes

Successful IP-Intensive Acquisition

Monopar Therapeutics, a biopharmaceutical company focused on developing innovative drug combinations to improve clinical outcomes in cancer patients, turned to Marshall Gerstein to assist with the acquisition of GPX-150, a broad spectrum Phase II Cancer drug candidate from Gem Pharmaceuticals. Marshall Gerstein’s attorneys, who also serve as Monopar’s IP prosecution counsel, structured the intellectual property contribution and assignment components for the IP-intensive acquisition. Our attorneys’ experience in both biopharmaceutical transactions and this specific technology,

enabled us to efficiently and effectively identify and integrate key terms to address the full range of intellectual property critical to the deal, which ultimately led to a timely and successful acquisition.